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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,660	04/08/2004	John G. Almli	AMS-040A	8025

40636 7590 01/22/2009

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EXAMINER	
BERTHEAUD, PETER JOHN	
ART UNIT	PAPER NUMBER
3746	

MAIL DATE	DELIVERY MODE
01/22/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/820,660	ALMLI ET AL.	
	Examiner	Art Unit	
	PETER J. BERTHEAUD	3746	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 October 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13 and 34-45* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13,34-39 and 41-45* is/are rejected.

7)☒ Claim(s) *40* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *08 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/27/2008 has been entered. It should be noted that claims 1, 2, 34, and 35 have been amended and claims 14-33 and 46-60 have been cancelled.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 37 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 37 it is stated that “an end portion of the second portion of the bar engaging an end of the first flow valve when the bar is in the first position"; however, it would seem that the first portion of the bar is the portion of the bar that engages the first flow valve, not the second. For example, in claim 38 it is stated that the second portion of the bar is parallel with the second compressible side wall; the

portion of the bar that is parallel with the second compressible side wall is certainly not the portion that is engaging the first flow valve.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-3, 13, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burton 5,141,509 in view of Doyle 3,510,029.

Regarding claim 1 (as well as disclosure pertinent to the rejection of claims 2-13):

Burton (Fig. 1) discloses a penile prosthesis having means for preventing spontaneous inflation comprising: a housing 40 having an outer wall with at least a portion of the outer wall being compressible (see 42, 44); a first flow valve 14 (see specifically the inclined section between 16 and 18) positioned within the housing and having a seated and an unseated position. Burton further discloses (claim 2) a first compressible side wall 42 positioned to intersect an axis defined by a path of travel of the first flow valve 14; (claim 3) wherein the housing has a substantially rectangular configuration. Burton also discloses (claim 13) a second flow valve 24 positioned such that when the first flow valve 14 is moved from the seated to the unseated position, the

first flow valve 14 contacts the second flow valve 24 and moves the second flow valve 24 from a seated to an unseated position (see Fig. 3).

Regarding claim 34:

Burton discloses a penile prosthesis having means for preventing spontaneous inflation comprising: a valve block 20 and a shell 40 attached to the valve block wherein the shell includes a pump bulb 10; and wherein the valve block includes a periphery with a pairs of opposing surfaces, and wherein upon one pair (42, 44) of said opposing surfaces of said valve block being compressed said inflatable prosthesis is deflated.

However, Burton does not teach the following claimed limitations taught by Doyle.

Doyle teaches a gas release apparatus comprising, a bar 44, having a flexible angularly extending arm (see 44, 48 in Fig. 4) used to open a valve (see col. 2, lines 9-14), wherein said flexible angularly extending arm of said bar is moveable between a first and a second position so that when the flexible angularly extending arm of said bar 44, 48 is moved from the first position to the second position the flexible angularly extending arm of said bar 44, 48 causes the first flow valve to move from the seated to the unseated position. Doyle further teaches the bar 44, 48 having a first portion 48 and a second portion 46; wherein a first portion of the bar 48 is positioned to intersect an axis defined by a path of travel of the valve from the seated to the unseated position; wherein the first 48 and second 44 portions of the bar are adjacent each other such that if either the first or the second portions are compressed, the bar 44, 48 is caused to engage the valve and move the valve from the seated to the unseated position (see col.

3, lines 6-12); and wherein (claim 5) an obtuse interior angle is formed between the first portion of the bar 48 and the second portion of the bar 46.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the valve block assembly of Burton by implementing the bar of Doyle and wrapping the compressible housing around the bar, thus creating a second compressible wall, in order to allow the user to actuate the release valve by compressing either of the pairs of opposing surfaces of the valve block. Furthermore, it is well known in the art to actuate a valve by forces perpendicular to that of the valve through the use of levers or angled bars.

6. Claims 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burton 5,141,509 in view of Doyle 3,510,029 and Middlestadt 2,786,718.

Regarding claim 35-45:

Burton (Burton, Fig. 1) discloses a penile prosthesis having means for preventing spontaneous inflation comprising: a housing 40 having an outer wall with at least a portion of the outer wall being compressible (see 42,44); a first flow valve 14 (see specifically the inclined section between 16 and 18) positioned within the housing and having a seated and an unseated position; Burton further discloses a first compressible side wall 42 positioned to intersect an axis defined by a path of travel of the first flow valve 14 from the seated to the unseated position. Burton further discloses (claims 43-44) a support member 20 coupled to the housing 40, wherein the support member 20 contacts a portion of the first flow valve 14 in such as manner as to prevent sideways movement of the first flow valve; wherein the support member 20 further comprises a

shelf (see valve seat for 14) in contact with the first flow valve 14. Burton also discloses (claim 45) a second flow valve 24 positioned such that when the first flow valve 14 is moved from the seated to the unseated position, the first flow valve 14 contacts the second flow valve 24 and moves the second flow valve 24 from a seated to an unseated position (see Fig. 3). However, Burton does not teach the following claimed limitations taught by Doyle and Middlestadt.

Doyle teaches a gas release apparatus comprising, a bar 44, having a flexible angularly extending arm (see 44, 48 in Fig. 4) used to open a valve (see col. 2, lines 9-14), wherein said flexible angularly extending arm of said bar is moveable between a first and a second position so that when the flexible angularly extending arm of said bar 44, 48 is moved from the first position to the second position the flexible angularly extending arm of said bar 44, 48 causes the first flow valve to move from the seated to the unseated position. Doyle further teaches the bar 44, 48 having a first portion 48 and a second portion 44 connected by a bend; wherein a first portion of the bar 48 is positioned to intersect an axis defined by a path of travel of the valve from the seated to the unseated position; wherein the first 48 and second 44 portions of the bar are adjacent each other such that if either the first or the second portions are compressed, the bar 44 is caused to engage the valve and move the valve from the seated to the unseated position (see col. 3, lines 6-12). Doyle further discloses (claim 37) that the bar 44 is a thin elongate member, an end portion of the first portion 48 of the bar engaging an end of the valve when the bar is in the first position.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the valve block assembly of Burton by implementing the bar of Doyle and wrapping the compressible housing around the bar, thus creating a second compressible wall, in order to allow the user to actuate the release valve by compressing either of the pairs of opposing surfaces of the valve block. Furthermore, it is well known in the art to actuate a valve by forces perpendicular to that of the valve through the use of levers or angled bars.

Middlestadt teaches a dispensing apparatus comprising: a bar 32, having a flexible angularly extending arm, comprising a spring (see col. 3, lines 1-6). Middlestadt further teaches that the bar 32 is moveable between a first and second position thus actuating the movement of fluid (see col. 3, lines 7-20).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the valve block assembly of Burton and Doyle by implementing a spring as the bar, as taught by Middlestadt, in order to allow the bar to lift the compressible sidewalls after being squeezed without relying only on the coil spring adjacent the valve; thus increasing the life of the valve assembly.

Furthermore, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, because apparatus claims cover what a device is, not what a device does (Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)). Thus, if a prior art structure is capable

of performing the intended use as recited in the preamble, or elsewhere in a claim, then it meets the claim.

7. Claims 36, 37, and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burton 5,141,509 in view of Doyle 3,510,029 in view of Middlestadt 2,786,718, and in further view of Leistner 5,595,331.

Burton in view of Doyle and Middlestadt discloses the invention as discussed above. However, Burton in view of Doyle and Middlestadt does not teach the following claimed limitations taught by Leistner.

Leistner teaches a bar 3 comprising two portions connected by a bend; the bar comprising a spring. Leistner further teaches (claim 39) that the bar 3 comprises at least one rib 4 extending across the bend; the rib 4 shaped to as to make the bar stiff, such that resistance to deflection forces is enhanced.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the valve block assembly of Burton, Doyle and Middlestadt, by implementing ribs into the bar, as taught by Leistner, in order to increase the resistance of the bar.

8. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burton 5,141,509 in view of Doyle 3,510,029, and in further view of Smye 2,586,575.

Burton in view of Doyle discloses the invention as discussed above. However, Burton in view of Doyle does not teach the following claimed limitations taught by Smye.

Smye teaches a relief valve apparatus comprising a housing 4, with a compressible wall 30 coupled to a valve 12. Smye further teaches a bar 18 that is

substantially parallel with the compressible side wall 30 (see inner side of 30) when the side wall 30 is in an uncompressed state (see Fig. 1). Smye further teaches that a segment of the first flow valve 12 includes a plastic member 24 disposed thereon such that the bar 18 contacts the plastic member 24 when the bar is in the first position (see Fig. 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the valve assembly of Burton in view of Doyle, by making the second compressible side wall parallel with the second portion of the bar when in an uncompressed state in order to have room between the housing wall and inner components so the wall can compress.

9. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burton 5,141,509 in view of Doyle 3,510,029, and in further view of Lambert 5,158,111.

Burton in view of Doyle discloses the invention as discussed above. However, Burton in view of Doyle does not teach the following claimed limitations taught by Lambert.

Lambert (Fig. 7) teaches a valve assembly comprising a bar 111, 109 and a valve 107. Lambert further discloses that the bar includes plastic and stainless steel (see col. 5, lines 14-16). Lambert also teaches (claim 41) that the flow valve 105 comprises a metal portion 111 and a synthetic portion 107.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the valve assembly of Burton in view of

Doyle, by implementing a valve and or valve bar which incorporates both steel and plastic in order to give the valve assembly stability as well as good sealing quality.

10. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burton 5,141,509 in view of Doyle 3,510,029, and in further view of Valentine 3,228,731.

Burton in view of Doyle discloses the invention as discussed above. However, Burton in view of Doyle does not teach the following claimed limitations taught by Valentine.

Valentine teaches a valve assembly comprising valve bar member 38. Valentine further teaches wherein the first portion of the bar (top end of 38) includes a curved free end wherein a curvature of the free end operatively associates with a curvature of the first flow valve (see cover over 38 that provides valve 36); wherein a curvature of the free end also operatively associates with a curvature of an interior portion of the outer wall (see wall above chamber 12).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the valve assembly of Burton in view of Doyle, by implementing a valve bar with a curved free end that operatively associates with an outer wall in order to allow the valve to reciprocate easily within the housing.

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burton 5,141,509 in view of Doyle 3,510,029, and in further view of Willard 6,171,233.

Burton in view of Doyle discloses the invention as discussed above. However, Burton in view of Doyle does not teach the following claimed limitations taught by Willard.

Willard (Fig. 1) teaches a penile pump assembly comprising a pump bulb 18 coupled to a housing 20, wherein the pump bulb 18 has a first exterior texture and the housing 20 has a second exterior texture that is different than the first exterior texture (see Fig. 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the pump assembly of Burton in view of Doyle, by implementing a pump bulb and housing with various textures in order to allow the user to better grip the elements.

12. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burton 5,141,509 in view of Doyle 3,510,029, and in further view of Keefe 5,328,293.

Burton in view of Doyle discloses the invention as discussed above. However, Burton in view of Doyle does not teach the following claimed limitations taught by Keefe.

Keefe discloses a tactile tile comprising a texture including a plurality of raised circular panels 8. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the pump assembly of Burton in view of Doyle, by implementing a texture on the housing that includes a plurality of circular raised panels in order to allow the user to gain a better grip on the housing (Keefe, col. 2, lines 12-17).

13. Claims 38, 39, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burton 5,141,509 in view of Doyle 3,510,029, in view of Middlestadt 2,786,718, in view of Leistner 5,595,331, and in further view of Smye 2,586,575.

Burton in view of Doyle, Middlestadt and Leistner discloses the invention as discussed above. However, Burton in view of Doyle, Middlestadt and Leistner does not teach the following claimed limitations taught by Smye.

Smye teaches a relief valve apparatus comprising a housing 4, with a compressible wall 30 coupled to a valve 12. Smye further teaches a bar 18 that is substantially parallel with the compressible side wall 30 (see inner side of 30) when the side wall 30 is in an uncompressed state (see Fig. 1). Smye further teaches that a segment of the first flow valve 12 includes a plastic member 24 disposed thereon such that the bar 18 contacts the plastic member 24 when the bar is in the first position (see Fig. 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the valve assembly of Burton in view of Doyle, Middlestadt and Leistner, by making the second compressible side wall parallel with the second portion of the bar when in an uncompressed state in order to have room between the housing wall and inner components so the wall can compress.

14. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burton 5,141,509 in view of Doyle 3,510,029, in view of Middlestadt 2,786,718 and in further view of Lambert 5,158,111.

Burton in view of Doyle and Middlestadt discloses the invention as discussed above. However, Burton in view of Doyle and Middlestadt does not teach the following claimed limitations taught by Lambert.

Lambert (Fig. 7) teaches a valve assembly comprising a bar 111, 109 and a valve 107. Lambert further discloses that the bar includes plastic and stainless steel (see col. 5, lines 14-16). Lambert also teaches (claim 41) that the flow valve 105 comprises a metal portion 111 and a synthetic portion 107.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the valve assembly of Burton in view of Doyle and Middlestadt, by implementing a valve and or valve bar which incorporates both steel and plastic in order to give the valve assembly stability as well as good sealing quality.

Allowable Subject Matter

15. Claim 40 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

16. Applicant's arguments with respect to claims 1-13 and 34-45 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

17. The prior art made of record in the attached form 892 and not relied upon is considered pertinent to applicant's disclosure.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PETER J. BERTHEAUD whose telephone number is (571)272-3476. The examiner can normally be reached on M-F 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Devon Kramer can be reached on (571) 272-7118. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charles G Freay/
Primary Examiner, Art Unit 3746

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/Peter J Bertheaud/
Examiner, Art Unit 3746